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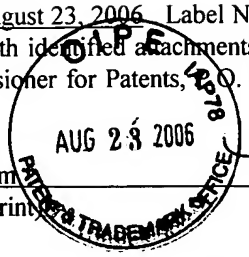

Kim Blum Kim Blum
Name (Print) Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	CHEN et al.	Examiner:	William P. Watkins III
Application Number:	10/697,532	Group Art Unit:	1772
Filed:	October 30, 2003	Confirmation No.:	7566
Docket No.:	3620-064-01	Customer No.	33432

For: A SURFACE COVERING PANEL

SUBMISSION OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 23, 2006

Sir:

Submitted herewith is an Appeal Brief for the above-identified U.S. patent application. A Petition for a three-month extension of time is filed herewith.

Also enclosed is a Credit Card Payment form that includes the amount of $500.00 to cover the cost of filing this Appeal Brief. In the event that any additional fees are due in connection with this paper, please charge such fees to Deposit Account No. 50-0925.

Respectfully submitted,

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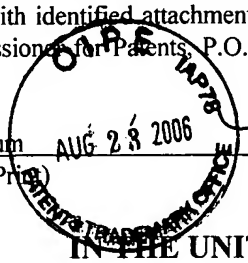
Date: August 23, 2006 Label No. EV908959654US I hereby certify that, on the date indicated above, I deposited this paper with identified attachments and/or fee with the U.S. Postal Service and that it was addressed for delivery to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 by "Express Mail Post Office to Addressee" service.



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APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 23, 2006

Sir:

This is an appeal to the Board of Patent Appeals and Interferences (hereinafter "the Board") from the Examiner's September 23, 2005 final rejection of claims 1-39 in the above-identified application. The appealed claims are set forth in the attached Appendix.

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I. TABLE OF CONTENTS

II. REAL PARTY IN INTEREST

The real party in interest, besides the named inventors, is Mannington Mills, Inc.

III. RELATED APPEALS AND INTERFERENCES

No other appeal or interference which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal is known to the appellants or the appellants' legal representative.

IV. STATUS OF CLAIMS

The claims pending in the application are claims 1-39.

Claims 1-39 are subject to this appeal. Each of the claims stands separately.

A copy of the claims on appeal can be found in the attached Claims Appendix.

V. STATUS OF AMENDMENTS

In response to the Office Action dated February 24, 2005, a Request for Reconsideration was filed on May 10, 2005, wherein no claim was amended. A final Office Action dated September 23, 2005 was received and no amendment was filed. Instead, a Notice of Appeal was filed. The appellants filed the Notice of Appeal with a Petition for a 3-month extension of time on March 23, 2006. The attached Claims Appendix contains the original claims.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates in general to surface covering products, such as floor products, and methods of making the same. More particularly, the present invention relates to surface covering products which provide a unique appearance, such as highly detailed printed patterns on a textured surface. As described at pages 1-3 of the present application, the conventional and standard approach to forming simulated designs on flooring products, such as laminate flooring, involves a method known in the art as "emboss-in-register," which involves embossing a textured design on a pre-printed layer wherein the pre-printed layer simulates the appearance of wood, tile, stone, and the like. The conventional approach carefully aligns the embossing plate so that the textured pattern matches (i.e., in registration with) the printed pattern, thereby achieving embossing in the appropriate places of the printed design to simulate grout lines, wood grains, ceramic depressions, and the like.

In more detail, the traditional floor covering with the simulated "natural" appearance of wood, tile or stone (or other designs), for instance, involves the registration of an embossed plate having a textured design to printed paper (on a substrate) having a pre-printed design. The design on the paper substrate is aligned with electronic sensors in both the machine and cross machine directions with the engraved design pattern of an embossed plate inside a press. The press is then closed and the paper substrate fused into a single panel containing the surface texturing. The disadvantage of an emboss-in-register process is that the embossing plate must be aligned on the printed pattern such that the embossed texture corresponds to the printed pattern. In other words, if the printed pattern has grout lines, the texture plate would have to be aligned such that the embossing of grout lines would match the print location of the grout lines. The alignment of the

embossing plate over the printed pattern can be a time-consuming and difficult task since the embossing plate can be a large object, and although controlled electronically, still requires adjustments and the aligning of the embossed pattern to the print pattern and is never within the matching tolerance that is most desirable. Essentially, the industry has learned to live with a certain degree of non-matching tolerance due to the limitations of the process. (*See*, for example, the entire text from page 1, line 6, to page 4, line 4, of the present application.)

The claimed invention on appeal overcomes the disadvantages of the traditional emboss-in-register floor covering and method of making thereof. The claimed invention essentially involves a surface covering pattern that is not embossed-in-register, but instead is printed-in-register. Unlike the conventional process, the present invention involves embossing a textured design first on a substrate, such as a support surface or layer that has a previously-applied base coating. Once the textured surface is created, a pattern is printed onto the textured surface in registration with the textured surface. Then, at least one protective coating is applied onto the printed pattern. As stated, this is a print-in-registration or, in other words, a printing-in-registration to the textured surface, which is the opposite of the conventional process which is an emboss-in-register to the printed pattern. The surface covering panel product of the present invention is different from conventional products in that the surface covering panel has a support layer and a base coating located on the support layer wherein a textured surface is present on the base coating and, optionally, the support layer, and a printed pattern located on the textured surface, which is in registration with the textured surface. The product further includes a protective layer located on the printed pattern. This is different from the conventional products, which are embossed-in-register surfaces, whereas the present invention is a print-in-registration surface. The products of the present invention are

different from emboss-in-register products in that by printing onto a textured surface, there are several advantages. First, in the conventional emboss-in-registration process, embossing typically occurs after printing and after a wear layer is provided. Thus, the embossing can damage the print layer and/or wear layer. Furthermore, when embossing on a print layer occurs, the embossing has the tendency to distort the printed design, whereas by printing on a textured design, the image is not distorted since no further distortion of the surface will occur. Also, as stated above, the tolerance of the matching of the textured surface to the print pattern is greatly improved with the present invention, such as $\pm$ 0.4 mm, and prefereably $\pm$ 0.1 mm, whereas the conventional process of emboss-in-register had a matching tolerance of $\pm$ 0.5 mm or higher, such that the emboss pattern does not fully match the print pattern. (*See*, for example, page 5, lines 7-12, of the present application.)

The present invention, as set forth in independent claim 1, overcomes the above disadvantages by providing a surface covering panel (see, for example, page 5, line 23-24 and Figs. 1-5, of the present application). The surface covering panel includes, as recited in claim 1,

at least one support layer with or without texturing (see, for example, page 6, lines 12-24, of the present application);

at least one base coating located on top of said support layer having a textured surface (see, for example, page 6, lines 22-24, and page 7, lines 11-18, of the present application);

at least one printed pattern located on said textured surface and in registered with said textured surface (see, for example, page 7, lines 1-3, of the present application);

and at least one protective layer located on the printed pattern (see, for example, page 7, lines 1-3, and page 8, line 19 to page 9, line 13, of the present application).

Dependent claims 2-17, 31-33, 37, and 38 are directly dependent on claim 1.

Dependent claim 2 provides that said printed pattern is a digital printed pattern (see, for example, page 9, lines 3-4, and lines 14-19, of the present application).

Dependent claim 3 provides that said printed pattern is a digital inkjet printed pattern (see, for example, page 8, lines 22-23 and page 9, lines 3-4, of the present application).

Dependent claim 4 provides that said printed pattern and said textured design is in register to about 1 mm or less (see, for example, page 9, lines 4-6, of the present application).

Dependent claim 5 provides that said textured design has an embossed depth of from about 3 mils to about 15 mils (see, for example, page 13, lines 12-24, of the present application).

Dependent claim 6 provides that said textured design has an embossed depth of from about 1 mil to about 15 mils (see, for example, page 13, lines 12-24, of the present application).

Dependent claim 7 provides that said printed pattern has a wood, tile, brick, ceramic, textile weave or stone pattern design (see, for example, page 2, lines 12-15, page 4, lines 8-9 and page 15, lines 16-17, of the present application).

Dependent claim 8 provides that said printed pattern has a resolution of at least about 100 dpi (see, for example, page 9, lines 9-11, of the present application).

Dependent claim 9 provides that said printed pattern has a resolution of from about 150 dpi to about 750 dpi (see, for example, page 9, lines 9-11, of the present application).

Dependent claim 10 provides that said support layer is a wood-based substrate (see, for example, page 6, lines 15-19, of the present application).

Dependent claim 11 provides that said support layer comprises a polymer-based layer (see, for example, page 6, lines 13-20, of the present application).

Dependent claim 12 provides that said support layer comprises particle board (see, for example, page 6, lines 13-19, of the present application).

Dependent claim 13 provides that said base coating comprises a polymeric layer (see, for example, page 7, lines 11-18, of the present application).

Dependent claim 14 provides that said at least one protective layer comprises a urethane top coat layer (see, for example, page 9, line 20 to page 10, line 3, of the present application).

Dependent claim 15 provides that said support layer has a textured surface (see, for example, page 6, lines 22-24, of the present application).

Dependent claim 16 provides that said support layer and said base coating have a textured surface (see, for example, page 6, lines 22-24, of the present application).

Dependent claim 17 provides that said support layer comprises a wood and fiber board composite (see, for example, page 6, lines 12-21, of the present application).

Dependent claim 31 provides that at least one adhesive base coat is located between said base coating and said support layer (see, for example, page 7, lines 19-20, of the present application).

Dependent claim 32 provides that said support layer is a surface treated support layer (see, for example, page 12, lines 8-16, of the present application).

Dependent claim 33 provides that said at least one protective layer comprises two protective layers (see, for example, page 10, lines 9-11, of the present application).

Dependent claim 34 is dependent on claim 33, and provides that one of the protective layers comprises a nano-composite urethane topcoat and the other protective layer comprises a urethane topcoat layer (see, for example, page 10, lines 4-13, of the present application).

Dependent claim 35 is dependent on claim 33, and provides that one of said protective layers comprises a low gloss nano-composite urethane topcoat layer and the other protective layer comprises a high gloss urethane topcoat layer (see, for example, page 10, lines 11-13, page 15, lines 7-10, and page 16, lines 18-22, of the present application).

Dependent claim 36 is dependent on claim 35, and provides that said high gloss urethane topcoat layer is located on top of said nano-composite urethane topcoat layer (see, for example, page 10, lines 4-13, of the present application).

Dependent claim 37 provides that said support layer comprises a high density fiber board (see, for example, page 7, lines 9-10, of the present application).

Dependent claim 38 provides that a bottom balance layer is located on the bottom of said at least one support layer (see, for example, page 8, lines 5-18, of the present application).

Claim 18 is a method claim that makes the surface covering panel of claim 1. The method comprises applying at least one base coating onto a support surface (see, for example, page 6, lines 22-24, page 7, lines 11-18, page 11, lines 22-23, and page 12, lines 5-10, of the present application);

applying a textured surface onto said base coating to form a textured surface (see, for example, page 6, lines 22-24, page 13, line 12 to page 14, line 9, of the present application);

printing a pattern onto said textured surface; and applying at least one protective coating onto said printed pattern (see, for example, page 7, lines 1-3, page 8, line 19 to page 9, line 13, and page 14, lines 10-24, of the present application);

wherein said textured surface and said printed pattern are in register (see, for example, page 7, lines 1-3, page 9, lines 4-9, and page 14, lines 14-24, of the present application).

Claims 19-27 and 29 are directly dependent on claim 18.

Dependent claim 19 provides that said printing is accomplished with an inkjet printing system (see, for example, page 9, lines 3-4, and page 14, lines 10-24, of the present application).

Dependent claim 20 provides that said printing is accomplished with a digital inkjet printing system (see, for example, page 8, lines 22-23 and page 9, lines 3-19, and page 14, lines 14-20, of the present application).

Dependent claim 21 provides that said textured surface is created with a platen press or an embossed roll (see, for example, page 13, lines 14-24, of the present application).

Dependent claim 22 provides that said printing is at a resolution of at least 100 dpi (see, for example, page 9, lines 9-13, and page 14, lines 16-20, of the present application).

Dependent claim 23 provides that said printing is at a resolution of about 150 dpi to about 750 dpi (see, for example, page 9, lines 9-13, and page 14, lines 16-20, of the present application).

Dependent claim 24 provides that the method comprises applying at least one adhesive base coating prior to applying at least one base coating onto said support surface (see, for example, page 7, lines 19-24, and page 12, line 21 to page 13, line 8, of the present application).

Dependent claim 25 provides that the method further comprises applying a bottom balance layer to the bottom surface of the said support surface (see, for example, page 8, lines 5-18, and page 16, lines 21-22, of the present application).

Dependent claim 26 provides that said support surface is surface treated prior to the application of at least one base coating (see, for example, page 12, lines 5-16, of the present application).

Dependent claim 27 provides that at least two protective coatings are applied (see, for example, page 10, lines 9-11, and page 15, lines 3-20, of the present application).

Dependent claim 28 is dependent on claim 27, and provides that one protective coating is a nano-composite urethane topcoat layer and the other protective layer is a urethane topcoat layer, wherein each protective layer optionally has different gloss levels (see, for example, page 9, lines 11-13, and page 15, lines 3-20, of the present application).

Dependent claim 29 provides that said support layer has a textured surface (see, for example, page 6, line 22 to page 7, line 3, and page 13, lines 12-14, of the present application).

The present invention, as set forth in independent claim 30, also overcomes the above disadvantages by providing a surface covering panel (see, for example, page 5, line 23-24 and Figs. 1-5, of the present application). The surface covering panel includes, as recited in pending claim 30,

at least one support layer having a textured surface (see, for example, page 6, lines 12-24, of the present application);

at least one base coating located on said support layer optionally having a textured surface (see, for example, page 6, lines 22-24, and page 7, lines 11-18, of the present application);

at least one printed pattern located on said textured surface and in registered with said textured surface (see, for example, page 7, lines 1-3, of the present application);

and at least one protective layer located on the printed pattern (see, for example, page 7, lines 1-3, and page 8, line 19 to page 9, line 13, of the present application).

The present invention, as set forth in independent claim 39, also overcomes the above disadvantages by providing a surface covering panel (see, for example, page 5, line 23-24 and Figs. 1-5, of the present application). The surface covering panel includes, as recited in pending claim 39,

at least one support layer with texturing; optionally at least one base coating located on top of said support layer with or without a textured surface (see, for example, page 6, lines 12-24, and page 7, lines 11-18, of the present application);

at least one printed pattern located on said support layer or said textured surface and in registered with said texturing on said support layer (see, for example, page 6, lines 22-24, and page 7, lines 1-3, of the present application);

and at least one protective layer located on the printed pattern (see, for example, page 7, lines 1-3, and page 8, line 19 to page 9, line 13, of the present application).

The Figures of the present application further show various embodiments of the claimed invention. Figure 1 represents one embodiment wherein the backing layer or support surface or core shown as 1 is the bottom layer and a base coating designated as 2 is located above core 1. The texturing or embossing is represented as 3, which in this embodiment is textured on the surface of the base coating 2. At least one printed pattern 4 is located above the base coating and is printed over the textured surface. The printed pattern can mimic the texture created or fully fill in the textured embossed patterned surface. At least one protective layer 5 is located above the printed pattern 4. With respect to Figure 2, the numerals are the same as described above except in this embodiment, the core 1 has a textured surface which can then be reflected in the various coatings applied above such that the textured surface is eventually reflected on the top surface, i.e., the protective coating 5. Figure 3 again represents the same layers as set forth in Figure 1. In this embodiment, the textured surface 3 is a textured surface which is on and through the base coating 2 and into core 1. If there are any other layers located between core 1 and base coating 2, these layers would also be textured as well such as an adhesive base coat layer identified as 7 in Figure 4.

With respect to Figure 4, this figure represents the various other optional embodiments. Any one of these layers or all of the layers reflected in Figure 4 can be used. The numerals previously discussed above with respect to Figure 1 are the same layers in Figure 4. An optional surface treatment of the core 1 can be done and this is identified as 10 in Figure 4. An optional at least one adhesive base coat layer 7 can be located between core 1 and the base coating 2. The protective layer can comprise two or more layers such as a nano-composite urethane topcoat layer or other type layer identified as 9 along with a urethane topcoat layer identified as 8. The glosses of each of these layers can be the same or different depending upon desired appearance. A bottom balance layer identified as 6 can be also used and is located at the bottom surface of core 1.

In Figure 5, the same layers are represented by the same numerals as discussed for the previous figures. Figure 5 shows an embodiment where the one of the protective layers 8 does not fully overlap protective layer 9 in order to create an optional contrasting gloss appearance. In Figures 4 and 5, embossing or textured surfaces are not shown to avoid any confusion but it is to be recognized that in Figures 4 and 5, any embossing as described earlier can be used such as the forming of a textured surface in core 1 or base coating 2 or both layers.

VII. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal by the Board of Patent Appeals and Interferences are as follows:

A. Claims 1 - 39 stand rejected under 35 U.S.C. §103(a) over Hansson et al. (U.S. Patent No. 6,465,046 B1) in view of Casto (U.S. Patent No. 1,947,459).

B. Claims 1 - 39 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 - 39 of U.S. Patent No. 6,617,009 in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto (U.S. Patent No. 1,947,459).

C. Claims 1 - 39 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 7 - 21, 31 - 33, 37 - 40 and 42 - 54 of copending Application No. 09/630,121 in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto (U.S. Patent No. 1,947,459).

D. Claims 1 - 39 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 45 - 73 of copending Application No. 10/909,684 in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto (U.S. Patent No. 1,947,459).

VIII. ARGUMENT

A. Rejection of Claims 1 - 39 under 35 U.S.C. §103(a) over Hansson et al. (U.S. Patent No. 6,465,046 B1) in view of Casto (U.S. Patent No. 1,947,459).

At page 2 of the final Office Action, claims 1 - 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hansson et al. (U.S. Patent No. 6,465,046 B1), in view of Casto (U.S. Patent No. 1,947,459). The Examiner alleged that Hansson et al. teaches the formation of a floor covering by optionally coating a core of wood or other material with an acrylic layer, then printing a digital pattern on the layer, then coating a wear coating, which may be a multi-layered structure and may contain nano-particles to enhance wear, followed by embossing of the layers in registration with the printing. The Examiner further alleged that Casto teaches forming a wood grain pattern on a surfacing material by embossing the core first and then putting pigment into the embossed areas in order to create a realistic design. The Examiner further alleged that the core may be coated and the coating embossed and the embossments filled with pigment to get multicolor effects. The Examiner noted that the present invention claims embossing a core, or a coating layer on a core with a design, and then printing in registration with the design by a digital printer with a high resolution. The Examiner took the position that it would have been obvious to have formed embossments in the core or coating layers of Hansson et al. and then to have printed in registration with digital means in order to make a better simulation of wood grain and other natural patterns because of the teachings of Casto.

At page 6 of the final Office Action, the Examiner disagreed with the appellants' arguments filed on May 10, 2005, that Casto just teaches forming depressions and filling them with pigment which is not printing and that no motivation was provided for combining Casto with Hansson et al.

The Examiner alleged that page 2, lines 90-130 of Casto teaches the reproduction of an image of a wood grain surface on a relief plate by a photo etching process so that the relief plate will produce half tones, full tones and quarter tones in the embossed surface in order to reproduce the image of the wood grain. The Examiner stated that claims 4 and 5 (of Casto) describe the relief plate as having a reverse "intaglio" surface. The Examiner alleged that half tone, full tone, quarter tone, and intaglio are specific terms in the printing art. Further, the Examiner alleged that the process of Casto reproduces an image in a surface using pigment and uses many terms from the printing art, and therefore, the Examiner has the opinion that one of ordinary skill in the art would clearly consider that Casto teaches a form of printing. Regarding motivation, the Examiner alleged that Casto teaches a printing process that produces the appearance of wood grain, marble and tile and that these appearances are "highly pleasing" when the process is used. The Examiner then alleged that Hansson et al. also has a printing and embossing process for wood grain patterns (col. 1, lines 18-22), and that there is motivation to modify Hansson et al. by embossing then printing in the depression to get a "highly pleasing" result.

For the following reasons, the Examiner's rejection should be reversed.

1) The rejection of claims 1-17 and 31-38 should be reversed.

Independent claim 1 is patentable over Hansson et al. in view of Casto.

Claim 1 differs from the teachings of the cited references in that Hansson et al. shows a product formed by printing onto a surface, then applying a lacquer coating and then embossing the lacquered surface. In other words, Hansson et al. only teaches printing, coating, and then embossing to form an embossed-in-register product. Hansson et al. does not teach or suggest a surface covering that has a surface that is first textured and then printed with a printed pattern in registration

with the textured surface as required by independent claim 1 of the present application. While process characteristics are discussed many times below, the process differences will lead to a different product as described above.

Process Scheme 1, found at cols. 7 and 8 of Hansson et al., and Process Scheme 2 found at col. 11 of Hansson et al., provide the summary of process steps used in Hansson et al. and the resulting product. As can be seen, the surface embossing is one of the final steps in the process of Hansson et al. Prior to surface embossing, Hansson et al. specifically teaches that a décor is printed on an upper surface of a core and that a base lacquer coating is applied thereafter. Then, the process states that wear-resistant particles are applied onto the lacquer coating. Process Scheme 1 of Hansson et al. then teaches that an additional lacquer coating is applied, as well as a top layer, whereas Process Scheme 2 only uses one lacquer coating, which is identified as a basic layer. After curing, surface embossing occurs in Hansson et al. It is respectfully noted that in every embodiment of Hansson et al., a décor is first created, then at least one lacquer coating is applied on top of the décor layer, and then a top surface layer is formed. Afterwards, and only afterwards, does surface embossing occur. Therefore, the surface embossing embosses one or more of the layers of the structure of Hansson et al., which is quite different from the claimed invention, which does surface or texture embossing prior to printing and further places a protective layer on top of the previously-embossed and previously-printed layer. Thus, the protective layer of claim 1 is not damaged or subjected to any stress caused by embossing. The Examiner does not seem to dispute the teachings of Hansson et al., but it is respectfully noted that Hansson et al. makes no teaching and makes no suggestion on modifying the process steps of the process set forth in Hansson et al. in order to obtain a different product. There is no suggestion in Hansson et al. or Casto of altering the

order of steps for any reason and, in fact, Hansson et al. emphasizes that the particular process steps lead to a desirable product as, for instance, stated at col. 4, lines 40-45, of Hansson et al. Thus, Hansson et al. provides no motivation or reason to modify the steps. To summarize, Hansson et al. merely shows an emboss-in-register product and in no way shows a print-in-register product as claimed in claim 1.

Moreover, Casto does not supply this missing feature. In Casto, a plaster or asbestos board is subjected to pressing to form interstices in the face of the board, then the entire surface is coated with a pigment, and then surplus pigment is scraped off so that pigment remains only in the interstices of the board. The Examiner is in error in interpreting the process/product of Casto as being a printing in registration with a textured surface, and the Examiner has not provided any proper reasoning or justification for the Examiner's conclusion that the claimed invention would be obvious over the combined references. The Examiner stated that it would have been obvious to modify Hansson et al. to form embossments in a core and then print in registration "because of the teachings of Casto." Contrary to what is alleged by the Examiner, the combination of the references does not teach or suggest the claimed invention and there is nothing in Casto that would teach or motivate a person skilled in the art to modify Hansson et al. to form embossments in a core and then print in registration.

In more detail, Casto, which dates back to 1928, relates to wall and partition board. While Casto relates to building materials, the various elements forming the wall board are significantly different from Hansson et al. As discussed above, Hansson et al. provides a multi-layer surface element, such as a laminate for flooring, which involves a possible surface treatment, a décor layer, a base lacquer coating, a top layer, wear-resistant particles, and surface embossing. *See* Process

Scheme 1 and Process Scheme 2 of Hansson et al. To the contrary, Casto relates merely to a wall board that is subjected to an impression plate (*see* page 1, lines 25-30 of Casto). This impression plate is used to exert a final gauging compression on the semi-finished board. As Casto states, for instance, at page 1, lines 54-66, the wall board or plaster board is subjected to an impression plate to reduce it from a semi-plastic to a hard consistency or when the board is being reduced to gauge thickness. Casto states that during this pressing, interstices are created in the finished face in order to give a "graining effect in simulation of the natural appearance of wood or the natural configuration or formation of the marble grain or vein usually present or observable in a slab of marble . . ." *See* page 1, lines 89-100 of Casto. After these interstices are formed, Casto states that they are filled with plastic pigment or plaster (by coating the entire board), which are different from the overall body structure of the board in order to create a contrast in colors. Casto, for instance, at col. 2, beginning at line 28, states that the treating of the board involves putting a plastic medium or pigment into the interstices, for instance, using a pressure roller, and that the pigment then fills the interstices and the surplus is removed from the board, which is not present in the interstices. In other words, Casto essentially teaches forming indentations in a board and then fills up only these indentations with a plastic pigment to create a smooth surface. This is further shown in Figs. 4-6 of Casto. It is respectfully noted that this process, contrary to the Examiner's position, cannot be a form of printing, but is merely a coating of a single color on the entire board and then the surplus is removed. Furthermore, contrary to the Examiner's position, by filling in the interstices and creating a smooth surface, there is no embossed surface remaining. These points are further confirmed in Casto, for instance, at page 2, lines 49-53, which states that the surplus pigment is entirely removed, except in the interstices of the board, and further at page 2, lines 71-72 which states that the smooth

filled surface exists afterwards. Casto then states that the entire board is treated with a stain, and that this stain creates various tones because of the "depth of the fillings in the cavities." *See* page 2, lines 71-75. This is further confirmed at page 2, lines 122-125.

Thus, contrary to the Examiner's position, an embossed surface does not exist in Casto once the interstices are filled with pigment and, further, the entire surface is stained and tones are created based on the varying depth of the interstices, which have been formed entirely with plastic pigment.

Further, contrary to the Examiner's position, Casto does not use "printing terms" as alleged by the Examiner, but merely refers to the different types of tones based on the varying depth of the interstices, which have been formed and filled with plastic pigment as indicated as page 2, lines 120-125. Furthermore, the various language referred to by the Examiner relates to the formation of the press plate, which the engraved relief surface can be created based on using a reverse Rembrandt screen for producing a carbon resist. *See* page 2, lines 101-112, of Casto.

When Casto is taken in its entirety and its teaching put side by side with Hansson et al., the technologies are different. Neither reference provides motivation to modify the process of Hansson et al. as alleged by the Examiner, and even if the teachings of Casto were combinable with Hansson et al., one would not come up with the claimed invention on appeal. In particular, Casto clearly teaches taking wall board and creating interstices at the time that the board is being reduced from a semi-plastic to a hard consistency or to reduce to gauge thickness. The purpose of this step clearly is not occurring in Hansson et al. In fact, if such a step was carried out in Hansson et al., the product would be destroyed. Hansson et al. clearly does not teach embossing to the degree that the thickness of the core is actually reduced. Clearly, the pressing that is occurring in Casto occurs at a different time in the making of a product and with a different product that does not have multiple

layers on top of the board. In other words, Casto does not emboss a multi-layered structure, but merely embosses a wall board or partition board that is not completely reduced to gauge thickness. This is entirely different from the product of Hansson et al.

Second, Casto does not use any décor layer or print layer and does not form any type of printed image, but merely coats the entire board with the same plastic pigment and then removes surplus pigment and then coats the entire board with stain. These steps are clearly coating steps and not printing steps, and there is no teaching or suggestion in Casto of printing a particular design, such as to simulate a natural appearance. This is quite different from Hansson et al., which clearly does print a décor layer on a core and, in fact, distinguishes printing from coating. Thus, Casto does not relate to any printing steps and in no way corresponds to any printing steps in Hansson et al.

Third, Casto, after forming interstices, fills these interstices entirely to form a "smooth filled surface" and then stains the entire surface. Hansson et al., on the other hand, prints a particular pattern, then forms several layers on top of the pattern, and eventually surface embosses. The surface embossing remains in the finished product. To the contrary, in Casto, any alleged embossing by the formation of interstices are clearly filled entirely so that there is no embossed surface that exists when the product is finished.

Fourth, neither Hansson et al. nor Casto provide any suggestion of modifying the process steps to create any alternative product. If one used the process of Casto in Hansson et al., the core of Hansson et al. would need to have a reduction in gauge thickness, and any surface embossing conducted in Hansson et al. would need to be completely filled with plastic pigment to create a smooth surface. These types of steps would ruin the product of Hansson et al. and defeat every

benefit alleged by Hansson et al. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, the Examiner has not shown any knowledge generally available to one of ordinary skill in the art to make the substitution and, as stated above, Hansson et al. and Casto certainly do not provide this teaching or suggestion or motivation. The problems solved by Casto are clearly different from the alleged problems solved by Hansson et al. and, therefore, one skilled in the art would not look to Casto for any solutions. Further, the material used and the various structures of each product of Casto and Hansson et al. are different.

Finally, contrary to the Examiner's position, Casto in no way relates to a printing-in-register. As indicated, Casto does not relate to any printing whatsoever and merely relates to coating. Also, the printing-in-registration to a previous embossing is clearly not described in Casto. Casto does not teach or even suggest any type of effort to align a print design to a previous emboss pattern. The Examiner has pointed to no portion of Casto which would teach or suggest this type of print-in-registration.

Regarding the Examiner's comments at page 6 of the final Office Action, the Examiner's description of Casto is incorrect and the analysis is flawed based on an incorrect comparison. Just because some of the terms used in Casto may be the same terms used in a printing process does not mean that Casto actually uses a printing process, especially one that is in register with a textured surface. For example, painting a wall can utilize "pigments" and "heat" to dry the paint, as printing a newspaper can also utilize "pigments" and "heat" to cure the ink. However, the two processes are

very different, just as the process of filling interstices of Casto's substrate or etching of Casto's pressing plate, as compared to the printing of a pattern to be in registered with appellants' textured surface. For instance, the terms that the Examiner referred to in Casto relates to etching the mat for the pressing plate **16**, and not for any printing process. See Casto, page 2, column 2, lines 109-132 and Fig. 3. More specifically, at page 2, column 2, lines 122-125, Casto uses these terms for the etching process in forming the depth of interstices, i.e., for the pressing plate, instead of for printing in the traditional sense. For claims 4 and 5 of Casto, mentioned by the Examiner, the term "intaglio" is recited within the context of pressing a material, i.e., by a pressing plate and not for printing. See claim 4 which recites "subjecting the semi-formed panel to pressure . . ." and claim 5 which recites "subjecting the panel to pressure against a reverse intaglio surface to thereby form in the panel surface a depressed design . . ." (emphasis added). Additionally, regarding the Examiner's motivation of getting a "highly pleasing" result, this is merely a general desirable characteristic that can apply to any product, and is not a specific motivation for combining the references. Further, the Examiner attempted to provide a proper motivation by stating that Hansson et al. also has a printing and embossing process for wood grain patterns, but this statement does not show a proper motivation from the Casto reference. The technique of Casto does not involve printing as discussed above and the numerous other differences described herein apply. Therefore, no clear and proper motivation was provided by the Examiner.

Thus, Hansson et al. in view of Casto does not teach or suggest the subject matter of claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. §103(a) over Hansson et al. in view of Casto should be reversed.

In addition, with respect to claim 4, which recites a printed pattern and texture design which

is in-registered to about 1 mm or less, this type of registration is clearly not taught or suggested in Casto at all. Casto does not even show any form of registration between any embossing and printed pattern and, in fact, as stated above, does not even relate to a printed pattern. Moreover, Hansson et al., at most, indicates a matching tolerance of up to $\pm$ 5 mm at col. 1, lines 25-28, and does not provide any other discussion regarding registration tolerance. It is respectfully noted that the present invention provides this tight tolerance, which is not possible in an emboss-in-register technique like Hansson et al. This is one of the advantages of the present invention.

Dependent claims 5, 6, 16, 31, 35, 36 and 38 are patentable over Hansson et al. in view of Casto. Claims 5, 6, 16, 31, 35, 36 and 38 include all of the limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claims 5, 6, 16, 31, 35, 36 and 38 should also be reversed for at least the same reasons. Reversal of the rejection of claims 5, 6, 16, 31, 35, 36 and 38, is additionally based on the following reasons. Hansson et al. and Casto, either singly or combined, do not teach or suggest the subject matter of claim 5: said textured design has an embossed depth of from about 3 mils to about 15 mils; claim 6: said textured design has an embossed depth of from about 1 mil to about 15 mils; claim 16: said support layer and said base coating have a textured surface; claim 31: at least one adhesive base coat located between said base coating and said support layer; claim 35: one of said protective layers comprises a low gloss nano-composite urethane topcoat layer and the other protective layer comprises a high gloss urethane topcoat layer; claim 36: said high gloss urethane topcoat layer is located on top of said nano-composite urethane topcoat layer; and claim 38: a bottom balance layer located on the bottom of said at least one support layer. Accordingly, the rejection of claims 4, 5, 6, 16, 31, 35, 36 and 38 under 35 U.S.C. §103(a) over Hansson et al. in

view of Casto should be reversed.

Dependent claims 2, 3, 7-15, 17, 32-34 and 37 are patentable over Hansson et al. in view of Casto. Claims 2, 3, 7-15, 17, 32-34 and 37 include all of the limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claims 2, 3, 7-15, 17, 32-34 and 37 should also be reversed for at least the same reasons. Accordingly, the rejection of claims 2, 3, 7-15, 17, 32-34 and 37 under 35 U.S.C. §103(a) over Hansson et al. in view of Casto should be reversed.

2) The rejection of claims 18-29 should be reversed.

Claim 18 is patentable over Hansson et al. in view of Casto. Claim 18 is dependent on independent claim 1, but is drawn to a method of making the surface covering of claim 1. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 18 should also be reversed for at least the same reasons. Method claim 18, as well as the claims dependent on claim 18, would be further patentable over Hansson et al. based on the process steps recited in claim 18. While the product recited in claim 1 of the present application is different from the product recited in Hansson et al. and would not be obvious in views of the arguments provided above, this is even more so with respect to the method recited in claim 18 of the present application. Claim 18 recites a particular sequence of steps which clearly are not shown in Hansson et al. as described above. Claim 18 recites first applying a base coating onto a support surface and then applying a textured surface onto the base coating to form a textured surface. Then, the method recites printing a pattern on the textured surface and applying at least one protective coating on the printed pattern. The method of printing the pattern is done in registration with the textured surface as recited in claim 18.

As indicated above, Hansson et al. clearly does not teach this sequence of steps and, in fact, teaches the opposite. In particular, Hansson et al. clearly teaches the process of printing a décor pattern on a core and then applying one or more layers on top of the décor pattern and then ultimately surface embossing at the very end. Thus, in Hansson et al., the surface embossing occurs as one of the last steps, whereas in claim 18, the method recites applying a textured surface prior to any printing and prior to applying any protective coating. The method steps are radically different when the claimed invention, as recited in claim 18, is compared to Hansson et al. In addition, as stated above, Hansson et al. does not teach or suggest any modification of these process steps, and Casto does not provide any motivation, teaching, or suggestion to conduct the steps as recited in claim 18 for the reasons previously given. Casto does not even relate to printing a pattern, but merely relates to creating interstices which are completely filled with plastic pigment to create a smooth surface, and then the surface is stained in its entirety. As stated above, if the teachings of Casto were somehow combined with Hansson et al., the process would not work in Hansson et al. Accordingly, the rejection of claim 18 under 35 U.S.C. §103(a) over Hansson et al. in view of Casto should be reversed.

Dependent claims 24, 25, and 28 are patentable over Hansson et al. in view of Casto. Claims 24, 25, and 28 have all of the limitations of claims 1 and 18, which were described above. Since the rejection of claims 1 and 18 should be reversed for the reasons indicated above, the rejection of claims 24, 25, and 28 should also be reversed for at least the same reasons. Reversal of the rejection of claims 24, 25, and 28 is additionally based on the following reasons. Hansson et al. and Casto, either singly or combined, do not teach or suggest the subject matter of claim 24: applying at least one adhesive base coating prior to applying at least one base coating onto said

support surface; claim 25: applying a bottom balance layer to the bottom surface of the said support surface; and claim 28: one protective coating is a nano-composite urethane topcoat layer and the other protective layer is a urethane topcoat layer, wherein each protective layer optionally has different gloss levels. Accordingly, the rejection of claims 24, 25, and 28 under 35 U.S.C. §103(a) over Hansson et al. in view of Casto should be reversed.

Dependent claims 19-23, 26, 27, and 29 are patentable over Hansson et al. in view of Casto. Claims 19-23, 26, 27, and 29 have all of the limitations of claims 1 and 18, which were described above. Since the rejection of claims 1 and 18 should be reversed for the reasons indicated above, the rejection of claims 19-23, 26, 27 and 29 should also be reversed for at least the same reasons. Accordingly, the rejection of claims 19-23, 26, 27 and 29 under 35 U.S.C. §103(a) over Hansson et al. in view of Casto should be reversed.

3) The rejection of claim 30 should be reversed.

Independent claim 30 is patentable over Hansson et al. in view of Casto. Claim 30 is similar to claim 1, except that claim 30 has the limitations wherein "at least one support layer" has a textured surface" and "said support layer optionally having a textured surface," while claim 1 has the limitations "at least one support layer with or without texturing" and "said support layer having a textured surface." Claim 30 has all of the other limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 30 should also be reversed for at least the same reasons. Accordingly, the rejection of claim 30 under 35 U.S.C. §103(a) over Hansson et al. in view of Casto should be reversed.

4) The rejection of claim 39 should be reversed.

Independent claim 39 is patentable over Hansson et al. in view of Casto. Claim 39 is similar to claim 1, except that claim 39 has the limitations "at least one support layer with texturing" and "optionally at least one base coating located on top of said layer with or without a textured surface" while claim 1 has the limitations "at least one support layer with or without texturing" and "said support layer having a textured surface." Claim 39 has essentially all of the other limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 39 should also be reversed for at least the same reasons. Accordingly, the rejection of claim 39 under 35 U.S.C. §103(a) over Hansson et al. in view of Casto should be reversed.

B. Rejection of claims 1-39 under the judicially created doctrine of obviousness-type double patenting over claims 1-39 of U.S. Patent No. 6,617,009 in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto (U.S. Patent No. 1,947,459).

At page 4 of the final Office Action, the Examiner rejected claims 1-39 under the judicially created doctrine of obviousness-type double patenting over claims 1-39 of U.S. Patent No. 6,617,009 ("the '009 patent") in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto (U.S. Patent No. 1,947,459). The Examiner alleged that the '009 patent claims a print layer with a cover layer on a core, and that the secondary references teach embossing and digital printing of a wood grain layer to have a better simulation. The Examiner took the position that the instant claims would have been obvious in view of the claims of the '009 patent as modified by the secondary references in order to provide a better simulation.

For the following reasons, the Examiner's rejection should be reversed.

1) The rejection of claims 1-17 and 31-38 should be reversed.

Obviousness-type double patenting is based on a judicially-created doctrine grounded in public policy so as to prevent the unjustified or improper time-wise extension of the right to exclude granted by a patent. The first question to be asked is: does any claim in the present application define an invention that is merely an obvious variation of the invention claimed in the patent? Since an analysis employed in an obviousness-type double patenting parallels the guidelines for 35 U.S.C. §103(a), it is respectfully submitted that the arguments set forth above with respect to the §103 rejection apply equally here since the Examiner is essentially relying on Hansson et al. and Casto to modify the claims of the '009 patent.

Furthermore, it is respectfully submitted that the claimed invention, which, as stated above, relates to a print-in-registration would not be an obvious variation of the thermoplastic laminate plank recited in the claims of the '009 patent. The Examiner has not explained at all how the alleged prior art references of Hansson et al. and Casto could be used to modify the claims set forth in the '009 patent to render the present claims obvious. This is especially true when the claims of the '009 patent relate to thermoplastic laminate planks and Casto relates to compressing wall board, which is a totally different type of material. Certainly, one skilled in the art reading the claims of the '009 patent would not consider the claims of the present application obvious since the claims do not even recite any type of printing in registration and do not recite any embossed surface as a requirement in the claims.

Further, modifying the '009 patent to add the features described in Hansson et al. and Casto would not result in the claimed invention, for the reasons discussed above regarding the Hansson et al. and Casto references taken alone. The '009 patent only adds to the above discussion is that it

discloses a print layer affixed to the top surface of a thermoplastic core. The claims of the '009 patent mention nothing about a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface.

Claims 1-39 of U.S. Patent No. 6,617,009 in view of Hansson et al. and Casto do not teach or suggest the subject matter of independent claims 1-17 and 31-38. Since the rejection of claims 1-17 and 31-38 should be reversed for the reasons indicated above and claims 1-39 of U.S. Patent No. 6,617,009 do not cure the deficiencies of Hansson et al. and Casto, this rejection under the judicially created doctrine of obviousness-type double patenting should also be reversed for at least the same reasons.

2) The rejection of claims 18-29 should be reversed.

Claims 1-39 of U.S. Patent No. 6,617,009 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claims 18-29. Claims 18-29 have all of the limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claims 18-29 should also be reversed for at least the same reasons. Reversal of the rejection of claim 18 is additionally based on the following reason. Claim 18 is a method claim that recites a specific sequence of steps to make a surface covering panel. It is respectfully noted that none of the claims of the '009 patent relate to method claims. For this reason alone, this rejection should be withdrawn since none of the claims set forth in the '009 patent would teach or suggest the process steps recited in claims 18-29 of the present invention. U.S. Patent No. 6,617,009, Hansson et al. and Casto, either singly or combined, do not teach or suggest a method of making a surface covering having the steps of applying at least one base coating onto a support surface; applying a textured surface onto said base coating to form a textured surface; printing a

pattern onto said textured surface; and applying at least one protective coating onto said printed pattern; wherein said textured surface and said printed pattern are in register. The references are also deficient with respect to specific claims that are dependent on claim 18, as discussed above. Accordingly, this rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

3) The rejection of claim 30 should be reversed.

Claims 1-39 of U.S. Patent No. 6,617,009 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claim 30. Claim 30 has similar limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 30 should also be reversed for at least the same reasons. Accordingly, this rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

4) The rejection of claim 39 should be reversed.

Claims 1-39 of U.S. Patent No. 6,617,009 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claim 39. Claim 39 has similar limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 39 should also be reversed for at least the same reasons. Accordingly, this rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

C. Provisional rejection of claims 1-39 under the judicially created doctrine of obviousness-type double patenting over claims 7-21, 31-33, 37-40 and 42-54 of copending Application No. 09/630,121 in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto

(U.S. Patent No. 1,947,459).

At page 4 of the final Office Action, the Examiner provisionally rejected claims 1-39 under the judicially created doctrine of obviousness-type double patenting over claims 7-21, 31-33, 37-40, and 42-54 of copending Application No. 09/630,121 in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto (U.S. Patent No. 1,947,459). The Examiner alleged that the '121 application claims printing on a core with a cover layer and that the secondary references teach embossing and digital printing of a wood grain layer to have a better simulation. The Examiner took the position that the instant claims would have been obvious in view of the '121 claims as modified by the secondary references in order to provide a better simulation.

For the following reasons, the Examiner's rejection should be reversed.

1) The rejection of claims 1-17 and 31-38 should be reversed.

The combination of Hansson et al. and Casto with the claims of the cited '121 application does not result in the claimed invention. Independent claims 31 and 47 of the '121 application recite a digital printed design on a top surface of a thermoplastic core and a protective layer affixed to the top surface of the digital printed design, but none of claims 7-21, 31-33, 37-40, and 42-54 mention anything about a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface. As discussed above, Hansson et al. and Casto in combination do not teach this feature and relate to different products. Accordingly, Hansson et al. and Casto, taken as secondary references, do not overcome the failure of the cited '121 application to teach or suggest a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface.

Claims 7-21, 31-33, 37-40, and 42-54 of copending Application No. 09/630,121 in view of

Hansson et al. and Casto do not teach or suggest the subject matter of claims 1-17 and 31-38. Since the rejection of claims 1-17 and 31-38 should be reversed for the reasons indicated above and claims 7-21, 31-33, 37-40, and 42-54 of copending Application No. 09/630,121 do not cure the deficiencies of Hansson et al. and Casto, this provisional rejection under the judicially created doctrine of obviousness-type double patenting should also be reversed for at least the same reasons.

2) The rejection of claims 18-29 should be reversed.

Claims 7-21, 31-33, 37-40, and 42-54 of copending Application No. 09/630,121 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claims 18-29. Claims 18-29 have all of the limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claims 18-29 should also be reversed for at least the same reasons. Reversal of the rejection of claim 18 is additionally based on the following reason. Copending Application No. 09/630,121, Hansson et al. and Casto, either singly or combined, do not teach or suggest a method of making a surface covering having the steps of applying at least one base coating onto a support surface; applying a textured surface onto said base coating to form a textured surface; printing a pattern onto said textured surface; and applying at least one protective coating onto said printed pattern; wherein said textured surface and said printed pattern are in register. The references are also deficient with respect to specific claims that are dependent on claim 18, as discussed above. Accordingly, this provisional rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

3) The rejection of claim 30 should be reversed.

Claims 7-21, 31-33, 37-40, and 42-54 of copending Application No. 09/630,121 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claim 30. Claim 30 has

similar limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 30 should also be reversed for at least the same reasons. Accordingly, this provisional rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

4) The rejection of claim 39 should be reversed.

Claims 7-21, 31-33, 37-40, and 42-54 of copending Application No. 09/630,121 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claim 39. Claim 39 has similar limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 39 should also be reversed for at least the same reasons. Accordingly, this rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

D. Provisional rejection of claims 1-39 under the judicially created doctrine of obviousness-type double patenting over claims 45-73 of copending Application No. 10/909,684 in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto (U.S. Patent No. 1,947,459).

At page 5 of the final Office Action, the Examiner provisionally rejected claims 1-39 under the judicially created doctrine of obviousness-type double patenting over claims 45-73 of copending Application No. 10/909,684 in view of Hansson et al. (U.S. Patent No. 6,465,046 B1) and Casto (U.S. Patent No. 1,947,459). The Examiner alleged that the '684 application claims a print layer on a core with a cover layer and that the secondary references teach embossing and digital printing of a wood grain layer to have a better simulation. The Examiner took the position that the instant claims would have been obvious in view of the '684 claims as modified by the secondary references in order to provide a better simulation.

For the following reasons, the Examiner's rejection should be reversed.

1) The rejection of claims 1-17 and 31-38 should be reversed.

The combination of Hansson et al. and Casto with the claims of the cited application does not result in the claimed invention. Independent claim 45 of the '684 application recites a print layer on a top surface of a thermoplastic core and a protective layer affixed to the top surface of the print layer, but none of claims 45-73 mention anything about a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface. As discussed above, Hansson et al. and Casto in combination also do not teach this feature and do not relate to thermoplastic cores. Accordingly, Hansson et al. and Casto, taken as secondary references, do not overcome the failure of the cited '684 application to teach a surface covering in which a surface is first textured and then printed with a printed pattern in registration with the textured surface.

Claims 45-73 of copending Application No. 10/909,684 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claims 1-17 and 31-38. Since the rejection of claims 1-17 and 31-38 should be reversed for the reasons indicated above and claims 45-73 of copending Application No. 10/909,684 do not cure the deficiencies of Hansson et al. and Casto, this provisional rejection under the judicially created doctrine of obviousness-type double patenting should also be reversed for at least the same reasons.

2) The rejection of claims 18-29 should be reversed.

Claims 45-73 of copending Application No. 10/909,684 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claims 18-29. Claims 18-29 have all of the limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the

reasons indicated above, the rejection of claims 18-29 should also be reversed for at least the same reasons. Reversal of the rejection of claim 18 is additionally based on the following reason. Copending Application No. 10/909,684, Hansson et al. and Casto, either singly or combined, do not teach or suggest a method of making a surface covering having the steps of applying at least one base coating onto a support surface; applying a textured surface onto said base coating to form a textured surface; printing a pattern onto said textured surface; and applying at least one protective coating onto said printed pattern; wherein said textured surface and said printed pattern are in register. The references are also deficient with respect to specific claims that are dependent on claim 18, as discussed above. Accordingly, this provisional rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

3) The rejection of claim 30 should be reversed.

Claims 45-73 of copending Application No. 10/909,684 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claim 30. Claim 30 has similar limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 30 should also be reversed for at least the same reasons. Accordingly, this provisional rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

4) The rejection of claim 39 should be reversed.

Claims 45-73 of copending Application No. 10/909,684 in view of Hansson et al. and Casto do not teach or suggest the subject matter of claim 39. Claim 39 has similar limitations of claim 1, which was described above. Since the rejection of claim 1 should be reversed for the reasons indicated above, the rejection of claim 39 should also be reversed for at least the same reasons.

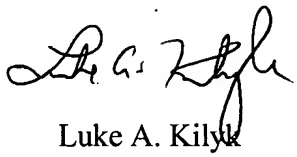
Accordingly, this rejection under the judicially created doctrine of obviousness-type double patenting should be reversed.

Conclusion:

For at least the reasons discussed above, it is respectfully submitted that the Examiner's rejection of all the pending claims is in error and should be reversed.

If there is any other fee due in connection with the filing of this Brief on Appeal, please charge the fee to our Deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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Claims Appendix

Claim 1. A surface covering panel comprising:

at least one support layer with or without texturing; at least one base coating located on top of said support layer having a textured surface; at least one printed pattern located on said textured surface and in registered with said textured surface; and at least one protective layer located on the printed pattern.

Claim 2. The surface covering panel of claim 1, wherein said printed pattern is a digital printed pattern.

Claim 3. The surface covering panel of claim 1, wherein said printed pattern is a digital inkjet printed pattern.

Claim 4. The surface covering panel of claim 1, wherein said printed pattern and said textured design is in register to about 1 mm or less.

Claim 5. The surface covering panel of claim 1, wherein said textured design has an embossed depth of from about 3 mils to about 15 mils.

Claim 6. The surface covering panel of claim 1, wherein said textured design has an embossed depth of from about 1 mil to about 15 mils.

Claim 7. The surface covering panel of claim 1, wherein said printed pattern has a wood, tile, brick, ceramic, textile weave or stone pattern design.

Claim 8. The surface covering panel of claim 1, wherein said printed pattern has a resolution of at least about 100 dpi.

Claim 9. The surface covering panel of claim 1, wherein said printed pattern has a resolution of from about 150 dpi to about 750 dpi.

Claim 10. The surface covering panel of claim 1, wherein said support layer is a wood-based

substrate.

Claim 11. The surface covering panel of claim 1, wherein said support layer comprises a polymer-based layer.

Claim 12. The surface covering panel of claim 1, wherein said support layer comprises particle board.

Claim 13. The surface covering panel of claim 1, wherein said base coating comprises a polymeric layer.

Claim 14. The surface covering panel of claim 1, wherein said at least one protective layer comprises a urethane top coat layer.

Claim 15. The surface covering panel of claim 1, wherein said support layer has a textured surface.

Claim 16. The surface covering panel of claim 1, wherein said support layer and said base coating have a textured surface.

Claim 17. The surface covering panel of claim 1, wherein said support layer comprises a wood and fiber board composite.

Claim 18. A method of making the surface covering panel of claim 1, wherein said method comprises applying at least one base coating onto a support surface;

applying a textured surface onto said base coating to form a textured surface;

printing a pattern onto said textured surface; applying at least one protective coating onto said printed pattern; wherein said textured surface and said printed pattern are in register.

Claim 19. The method of claim 18, wherein said printing is accomplished with an inkjet printing system.

Claim 20. The method of claim 18, wherein said printing is accomplished with a digital inkjet

printing system.

Claim 21. The method of claim 18, wherein said textured surface is created with a platen press or an embossed roll.

Claim 22. The method of claim 18, wherein said printing is at a resolution of at least 100 dpi.

Claim 23. The method of claim 18, wherein said printing is at a resolution of about 150 dpi to about 750 dpi.

Claim 24. The method of claim 18, further comprising applying at least one adhesive base coating prior to applying at least one base coating onto said support surface.

Claim 25. The method of claim 18 further comprising applying a bottom balance layer to the bottom surface of the said support surface.

Claim 26. The method of claim 18, wherein said support surface is surface treated prior to the application of at least one base coating.

Claim 27. The method of claim 18, wherein at least two protective coatings are applied.

Claim 28. The method of claim 27, wherein one protective coating is a nano-composite urethane topcoat layer and the other protective layer is a urethane topcoat layer, wherein each protective layer optionally has different gloss levels.

Claim 29. The method of claim 18, wherein said support layer has a textured surface.

Claim 30. A surface covering panel comprising:

at least one support layer having a textured surface; at least one base coating located on said support layer optionally having a textured surface; at least one printed pattern located on said textured surface and in registered with said textured surface; and at least one protective layer located on the printed pattern.

Claim 31. The surface covering panel of claim 1 further comprising at least one adhesive base

coat located between said base coating and said support layer.

Claim 32. The surface covering panel of claim 1, wherein said support layer is a surface treated support layer.

Claim 33. The surface covering panel of claim 1, wherein said at least one protective layer comprises two protective layers.

Claim 34. The surface covering panel of claim 33, wherein one of the protective layers comprises a nano-composite urethane topcoat and the other protective layer comprises a urethane topcoat layer.

Claim 35. The surface covering panel of claim 33, wherein one of said protective layers comprises a low gloss nano-composite urethane topcoat layer and the other protective layer comprises a high gloss urethane topcoat layer.

Claim 36. The surface covering panel of claim 35, wherein said high gloss urethane topcoat layer is located on top of said nano-composite urethane topcoat layer.

Claim 37. The surface covering panel of claim 1, wherein said support layer comprises a high density fiber board.

Claim 38. The surface covering panel of claim 1, further comprising a bottom balance layer located on the bottom of said at least one support layer.

Claim 39. A surface covering panel comprising:

at least one support layer with texturing; optionally at least one base coating located on top of said support layer with or without a textured surface; at least one printed pattern located on said support layer or said textured surface and in registered with said texturing on said support layer; and at least one protective layer located on the printed pattern.

EVIDENCE APPENDIX

No evidence that has been entered by the Examiner is relied upon by the appellants.

RELATED PROCEEDINGS APPENDIX

None